IN THE

Supreme Court of the United States

OCTOBER TERM, 1958

No. 881

WM. T. ALVARADO SALES CO. and
SPEE-DEE CHECKOUT SYSTEMS, INC.,
Petitioners,
vs.
SIDNEY S. RUBALOFF and ABRAHAM M. GROSS,
individually and doing business as
CHECK-A-MATIC CO.,
and
DU-MORE FIXTURE CO., INC.,
Respondents

PETITION FOR WRIT OF CERTIORARI

TO THE UNITED STATES COURT OF APPEALS
FOR THE NINTH CIRCUIT

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INDEX

	Page
Petition for Writ of Certiorari	1
Opinions Below	2
Opinions Below	Appendix
Jurisdiction on Writ	2
Questions Presented	2
Statutes Involved	4
Statement	5
Claims of Patent In Suit	7
Argument	9
Question 1	9
Question 2	12
Question 3	14
Question 4	15
Question 5	16
Question 6	17
Conclusions	18
Appendix:	
Opinion of Circuit Court of Appeals	1a
Judgment of Circuit Court of Appeals	10a
Order Denying Rehearing	11a

INDEX OF AUTHORITIES

Great Atlantic and Pacific Tea Co. v. Supermarket Equipment Corp., 340 U. S. 147 .... 6, 12, 13, 18, 19, 20

Smith v. Magic City Kennel Club, 282 U. S. 784 .... 12, 18

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Petitioners, William T. Alvarado Sales Co. and Spee-Dee Checkout Systems, Inc., pray that a writ of certiorari issue to review the judgment of the Circuit Court of Appeals for the Ninth Circuit affirming the decisions of the United States District Court, Southern District of California, Central Division.

OPINIONS BELOW

The findings of fact and conclusions of law of the District Court and the minute order on which they were based are unreported and appear at record pages 25 to 35. The opinion of the Circuit Court of Appeals is reported at 120 USPQ 355 and a copy is appended hereto.

JURISDICTION

The judgment of the Circuit Court of Appeals, which the petitioners here seek reviewed is dated February 6, 1959. A petition for rehearing was filed in the Circuit Court of Appeals on March 4, 1959 and an order denying the petition was dated March 19, 1959. This petition is, therefore, timely. The jurisdiction of this Court to review this judgment is contained in Title 28 United States Code, Sections 1254 (1) and 2101 (c), of the Act of June 25, 1948.

QUESTIONS PRESENTED

1. May a court, having found and stated that the device of a patent has "superior qualities" and that its components perform an old function differently and better than the closest prior art, proceed to invalidate the patent on the device *solely* on the ground that the degree or quantum of superiority and betterment does not attain some indeterminate prerequisite level, the level not being defined by the court or in any precedent cited by the court?

2. May a court, having found and stated that the use of an element of a patent is taught, in general terms, by the prior art but "not in the position and with all the advantages shown in the patent", and further stated that

the device of the patent functions differently than the most closely related prior art to reduce a hazard or objectionable feature of prior art devices, and without finding or indicating wherein the prior art teaches or suggests the combination of the device of the patent, proceed to hold that the combination of the device of the patent is a nonpatentable aggregation?

3. Should a court entirely disregard the presumption of validity arising from the issuance of a patent and hold the patent invalid without pointing out wherein prior art substantially and materially different from that considered by the Patent Office teaches or suggests the combination of the patent?

4. May an appellate court, having found and stated that an element of a patented device performs a function in the device that is in addition to the function performed by the most closely related element in the prior art, and having further stated that the closest prior art functions in a less convenient manner than the patented device which includes the element and its additional function, proceed to sustain a finding by a lower court that all of the components of the claimed invention make no improvement over the prior art?

5. May an appellate court, having found and stated that an element of a patented device is employed therein in a new position to produce new advantages and have a new and added function in an admittedly novel combination, proceed to sustain a finding by a lower court that the function of each of the components of the device is no different from the function of the same components as disclosed in the prior art, and to hold the patent invalid as an unpatentable aggregation?

6. May a court invalidate a patent on the grounds that the several components of the patented device, described in broad and general terms by the court, have broadly and generally stated functions that are old, without according any significance to specific novel relationships and details of those components as stated in the claims of the patent, and without according any significance to specific novel functions and advantages found by the court to exist within the broad definitions of the generalized functions stated by the court in its decision?

STATUTES INVOLVED

The questions here presented involve the construction of the patent law and more particularly Title 35 United States Code, sections 101, 103 and 282, Act of July 19, 1952, c 950, 66 Stat. 792 as follows:

35 USC 101. Inventions Patentable:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title".

35 USC 103. Conditions for patentability: non-obvious subject matter.

"A patent may not be obtained though the invention is not identically disclosed or described as set forth in Section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. * * *."

35 USC 282. Presumption of validity; defenses:

"A patent shall be presumed to be valid. The burden of establishing invalidity of a patent shall rest on a party asserting it. * * *"

STATEMENT

The actions involved in this petition are for infringement of United States Patent No. 2,599,909 issued to Will L. George Corporation, as assignee of the inventor William L. George. Petitioner Spee-Dee Checkout Systems, is successor to Will L. George Corporation by change of corporate name and petitioner William T. Alvarado Sales Co. is exclusive licensee of Spee-Dee Checkout Systems, Inc. in the State of California. The device of the patent is referred to as a check stand and is used to facilitate the operation of receiving the multiple items of a customer's grocery purchase, checking and recording the price of each item, receiving payment for the total, and advancing the checked items for packaging.

The courts below considered the device of the patent in its entirety rather than as defined by the claims. In the words of the Court of Appeals the stand is designed to speed up the operation of checking each item and to reduce the possibility of error in missing items or checking a single item twice. The structure is not complex. A rotatable receiving table is actuated by a concealed motor controlled by a switch operated by the checker. This turntable adjoins a discharge counter so that articles may be slid from the receiving table to the discharge counter. A support panel, constructed slightly above the quadrant of the turntable furthest from the customer and closest to the checker, provides a convenient place for the cash register. The left side of the support panel may also

perform the additional function of acting as a stop for the articles being purchased. When the turntable is used to convey the articles to the checker the arcuate movement of the turntable conveys the articles transversely away from the customer and toward the checker. This tends to bring the articles within easy reach and vision of the checker and his conveniently located cash register. It also operates to reduce the likelihood that articles will be inadvertently or fraudulently passed by without checking.

The prior art which comes closest to having the same advantages is the Bradley patent using a conveyor belt. If a customer rather than an attendant unloads the articles upon the belt, a substantial number of the articles are likely to be placed on the customer's side of the belt. To the extent that this is done, either by the customer or the attendant, the articles will come to a stop at a place which is less convenient for the checker. Both appellants and appellees will be able to suggest claimed advantages called to our attention which are not mentioned in this opinion. It is at once apparent that the George check stand is useful. (End of extracts from Court of Appeals Opinion.)

The charges of infringement are based on manufacture and sale by defendants of check stands of which the Court of Appeals stated:

> "The completness with which appellees have imitated the essential features of the George device is probably indicative of its superior qualities."

The conclusion of the Court of Appeals on which this Petition is based is as follows:

> "Applying the test of the A & P case to the uncontroverted facts before us here, we hold that the trial court did not err in concluding that the

George device is a non-patentable aggregation of old components and therefore invalid. Its components do not perform any additional or different function in the combination than they perform out of it. To be sure, they perform this same function differently, and perhaps better. This difference and betterment, evidences the practical application of a good idea. It is not, however, an idea which in practice has produced such unusual or surprising consequences or has so added to the total stock of knowledge that it represents invention in the constitutional sense."

The patent contains 7 claims of which 3, 5, 6 and 7 are in suit. The patent appears at page 250 of the record and pictures of three of the accused check stands appear at pages 263, 269 and 298 of the record.

The claims in suit are as follows:

3. A checking stand for a grocery store and the like comprising a register support panel having a stop portion along one edge thereof, a turntable mounted to rotate partially underneath said panel whereby articles placed on said turntable will be carried thereby against said stop portion, a discharge counter extending from said turntable adjacent to said support panel, the end of said discharge counter extending from said stop portion arcuately away therefrom for a substantial distance along the periphery of said turntable, said discharge counter extending longitudinally from said end with its inner edge concavely arcuate with respect to said support panel, a guard ring around the exposed edge of said turntable and extending inwardly over the outer edge of said discharge counter to direct items on said table toward said stop portion, a motor for rotating said turntable, and means for controlling said motor located behind said discharge counter for operation by the operator of said stand.

5. A checking stand for self-service stores comprising a base, a turntable rotatably mounted above part of said base, a discharge counter supported above the remainder of said base and extending as a continuation from a portion of the periphery of said turntable, a register support panel supported above a quandrant of said turntable adjacent to said counter whereby said turntable will rotate freely in closely spaced relation underneath said support panel, a motor for rotating said turntable, and a switch for regulating said motor.

6. An apparatus of the class described comprising a rotatable receiving table, a stationary guard rail for a substantial portion of the rim of said receiving table, a discharge counter disposed in the plane of said receiving table and having a portion thereof conformed to a segment of the table so that articles may be slid from the receiving table to the discharge counter, means forming a stop for articles on the receiving table and a register support disposed above the plane of said receiving table at the side of said stop, and means for rotating said receiving table.

7. A checking stand for self service stores comprising, an item receiving counter of generally circular outline mounted to rotate in the plane of its surface, a register support positioned in closely spaced relation over a sector of said receiving counter and having a side edge extending generally radially of said receiving counter to the periphery thereof to form an article stop for articles rotated thereagainst by said receiving counter, and a discharge counter extending as a generally co-planer extension of said receiving counter from another sector of said receiving counter adjacent said stop.

Jurisdiction of the District Court applied in the first instance under 28 USC sections 1338 and 1400 (b) all defendants being residents of the district of the Court and having committed acts of infringement in that district.

ARGUMENT

It is respectfully submitted that the foregoing statement of the case fairly raises the questions posed by this petition. Bearing in mind that the facts stated are almost entirely the words of the Court of Appeals and that they were selected by that Court to support and substantiate a holding of invalidity of the patent in suit, they represent a minimum of the favorable attributes of the patent and petitioners cannot be said to overly laud the device of the patent or to have improperly attributed functions and advantages thereto in phrasing the questions submitted.

The questions posed are vital to the proper interpretation of the federal law of patents and if answered in the affirmative, as decided by the Court of Appeals, would completely change the law as defined by statute and stated by this Court. It follows that this Court should exercise its power of judicial review to correct the decision of the Court of Appeals which is in conflict with both the applicable statutes and applicable decisions of this Court.

QUESTION 1

IS DEGREE OF IMPROVEMENT A SOLE TEST OF VALIDITY?

Section 103 of Title 35 USC states the grounds on which a patent may be refused or invalidated even though not directly and fully anticipated by the prior art. Recognizing the presence of novelty and utility required by section 101 and found by the Court of Appeals to exist in this

case, the only limitation on patentability is the requirement of a difference between the patent and the prior art which would not have been obvious to a person skilled in the art. This statutory requirement is a codified statement of prior judicial interpretations (*Smith v. Magic City Kennel Club*, 282 U. S. 784, 515 Ct. 291 [7]) which has been rephrased and restated in countless judicial decisions.

Certainly the derived question of what was or was not obvious to a person skilled in the art in any particular case is a thorny question and many tests have been stated for determining it but the present case presents no such question. The Court of Appeals in its decision does not attempt to state wherein any prior art suggested or taught the combination of the George patent. Nor does the Court of Appeals apparently consider that any question relating to the suggestive powers of the prior art exist in this case. Petitioners are confident that no such suggestion by the prior art exists and for the purpose of this Petition it need only be noted that the Court of Appeals found no anticipating sugestion.

The final conclusion of the Court of Appeals is stated and rested squarely and solely on an evaluation of the commercial value of the device of the patent in use. After noting that the device performs an old function differently and perhaps better and that it is a practical application of a good idea the Court of Appeals states:

> "It is not, however, an idea which *in practice* has produced such unusual or suprising consequences or has *so added* to the total stock of knowledge that it represents invention in the constitutional sense." (Emphasis added.)

Preceded, as it is, by stated findings of new and additional functions of elements and different and improved function of the device, and without any indication wherein the prior art suggests the device or its function, it is apparent that the Court of Appeal's decision merely tries to evaluate the end result or commercial value of the device. The Court of Appeals was trying to establish some minimum commercial value of the improvement created by a patent which the Court would approve as sufficient. While petitioners are not in accord with the minimized statement of the improvements as stated by the Court of Appeals, for the purpose of this petition they accept the Court's finding that there was "a difference" and "an improvement" and a "new function" in the device in suit. Petitioners can only point to the fact that the statutes only require a new and improved device and qualify this only by a requirement of unobvious combination. No limitation of the extent or commercial value of the improvement is involved. Neither does any decision of this Court set as a test or pre-requesite any minimum level or quantum of improvement above and beyond the bare existence of some improvement and betterment.

It follows that the Court of Appeals was improperly attempting to invoke, by judicial decision, some additional requirement not provided by statute or the decisions of this Court.

QUESTION 2

CAN BROAD GENERALITIES OF FUNCTION OVERRIDE AND HOLD SPECIFIC IMPROVEMENTS AGGREGATIVE?

This question is closely related to the first question but brings in the subordirate question of patentable combination as distinguished from unpatentable aggregation. As pointed out by this Court in *Great A & P Tea Co. v. Supermarket Equipment Corp.*, 340 U. S. 147, this distinction in the patent law is merely a distinction in terms to designate patentable and unpatentable devices which comprise old elements. The use of one term or the other is not the basis of a decision but the decision itself which must be based on other factors. In the above cited Supermarket case this Court reaffirmed as a requirement for a patentable combination the prerequisite that the parts of a device perform a new or different function from the functions performed by the same parts in their old environment.

Neither the Supermarket case or the statutes, as pointed out above under Question 1 attempts or authorizes a bare appraisal of commercial value as a test of patentability. The Supermarket case is an evaluation or examination of the components of a new device as compared to those same elements as found in the prior art. There is no similar comparison of elements in the present case. Where in the Supermarket case it was found that each component did not perform any added or different function in the combination than the same elements performed out of it, this case finds, according to the Court of Appeals, that at least one component performs an added function (the register support panel performs the added function of acting as a stop), and the components, located in a new

position with advantages over the prior art, perform an old function differently and better.

The patent in the Supermarket case was not invalidated because it performed a function that was generally old but because its components each performed only their identical and individually old function. The Court of Appeals misinterprets the Supermarket decision when it generalizes the functions of article advancing, register supporting and article discharging to the turntable, register support and discharge counter of the George patent. In fact the decision of the Court of Appeals is contradictory and inconsistent within itself. How can the register support of the George device perform the "added function" of a stop and still do only what register supports had previously done? How can the aggregate or combination of elements in the George device perform the same old functions if one element has at least one added function? How can the check stand of the George patent reduce the likelihood of articles being fraudulently passed by and present articles at a more convenient checking position as stated by the court and still perform only the same old functions? Something has been changed and the combination produces something in addition to the sum of the old functions of the components.

It is thus apparent that the Court of Appeals did not recognize as sufficient the existence of facts and relationships which this Court has described as sufficient. While the Court of Appeals does not directly contradict this Court's decision in the Supermarket case it decides the instant case on grounds that are both inconsistent with the Supermarket decision and inconsistent with the facts which the Court of Appeals itself states. This Court should accordingly exercise its supervisory jurisdiction to

the ends that justice will prevail in the instant case and that this Court's decisions will not be misinterpreted in similar cases.

QUESTION 3

PRESUMPTION

Little can or need be said about this question except to point out the absolute statement of Section 282 of Title 35 USC that a patent shall be presumed valid and the complete absence from the Court of Appeal's decision of any indication wherein the Patent Office failed to consider some pertinent piece of prior art or failed to give proper and sufficient consideration to the prior art it did cite. Petitioners are aware of the many instances in which the presumption of validity has been rebutted but all involve facts or circumstances under which courts have found that through errors of the Patent Office, proior art was in existence that suggested the device of the patent in question.

An omission cannot be quoted and here petitioners can only point to the fact that no where in its decision does the Court of Appeals mention the presumption of validity of the patent in suit or point out wherein the Patent Office failed to consider pertinent prior art or failed to give proper interpretation to the art it did consider. If the Court of Appeal's discussion of the relative value of the patented check stand and prior art stands, and the extent or degree to which the patented stand is an improvement over prior stands is considered to be a study of the Patent Office's deliberations, then that discussion and study is entirely insufficient to overthrow the Patent Office's finding of patentability in the George checkstand. Certainly the Court of Appeals' analysis would be an im-

proper guide to future Patent Office action. Assuming that the Patent Office found the facts of extra added function of the support panel, new and different functions of parts and the added function of transverse movement of articles and less chance of fraudulently passing articles past the checker, all as stated by the Court of Appeals, the Patent Office would have been and was in fact clearly justified under the decision in the Supermarket case in allowing the patent in suit.

QUESTION 4

TRIAL COURT FINDING OF NO IMPROVEMENT WAS IN ERROR

The question is really a detail of the broader question posed in Questions 1 and 2 but it emphasizes the inconsistency of the Court of Appeal's decision. The decision and opinion sustain, without specific comment, the trial court's finding of fact 8 (R. 33) to the effect that the patent in suit does not possess an improvement over the prior art. And yet the Court of Appeals specifically says about the structure of the George check stand:

> "The left side of the support panel may also perform the additional function of acting as a stop * * *."
>
> "The use of a register support, *though not in the position and with all the advantages shown in the George patent* is taught in Bradley * * *."
>
> "* * * the arcuate movement of the turntable *conveys the articles transversely* away from the customer and toward the checker. This tends to bring the articles *within easy reach and vision of the checker* and his *conveniently located cash register*. It also operates to *reduce the likelihood* that articles will be inadvertently or fraudulently passed by without checking."

"The prior art which comes closest to having the same advantages is the Bradley patent * * * to the extent that this is done (in Bradley) the articles *will come to a stop at a place which is less convenient* for the checker."

"* * * the George check stand is useful. The completeness with which appellees have imitated the essential features of the George device *is probably indicative of its superior qualities.*"

"To be sure they (components of the George check stand) perform this same function differently, and perhaps better."

It is respectfully submitted that the Court of Appeals' decision is on its face both inconsistent and erroneous in finding improvements and added function on the one hand and sustaining the trial court's findings on the other. This error and inconsistency can only be corrected by review by this Court.

QUESTION 5:

CAN NEW AND DIFFERENT FUNCTIONS IN PATENT SUPPORT HOLDING OF AGGREGATION?

This question is, like question 4, an included but particularly apparent and important part of broader questions 1 and 2. The Court of Appeals' decision approves, without specific comment, the trial court's finding 9 (R. 34) to the effect that each of the components of the patent in suit perform no function that is different from the function performed in the prior art by the related components. The finding also holds there is no new relationship between the component parts of the patent in suit.

This approval is submitted to be patently erroneous in view of the statements quoted above in which the Cir-

cuit Court of Appeals specifically finds that the register support panel performs an "added function" and that the components are arranged in a relation that is different than the closest prior art and have advantages not provided by the prior art. Petitioners cannot imagine any logical explanation that would answer question 5 in the affirmative and not require review of the decision of the Court of Appeals.

QUESTION 6

MUST COURT CONSIDER SPECIFIC DIFFERENCES AND IMPROVEMENTS WITHIN BROAD FUNCTIONS THAT MAY BE BROADLY OLD?

Petitioners find no fault with the generalizations by the Court of Appeals that it is old to mechanically advance articles to a checking area in a check stand and to support a cash register near that position and provide a discharge counter to receive articles after they are checked. Nor do petitioners deny that the components of the George check stand perform these functions. That was the starting point of George's development. In fact petitioners insist that the George check stand performs the functions and does it in a new and improved manner. From the portions of the Court of Appeals' decision already quoted and referred to several times it is apparent that the Court of Appeals agrees with petitioners on this point. A single improvement resulting from an unobvious combination is often held to support a patent and yet the Court of Appeals bases its final conclusion of invalidity on the similarity of broad, overall functions of the patented stand and prior art stands and this in spite of its prior recognition of specific points of improvement and difference.

While the question of specific limitations in clai
usually arises in connection with the scope and infrin
ments of the claims, it is universally accepted that an
vention and the validity of a patent thereon is determi
by the claims. *Smith v. Magic City Kennel Club*, 282 U.
784, holds that all elements of a claim to a combinati
must be regarded as material. It follows that a spec
function which results from a specific element or limi
tion of a claim is material to that claim and its valid
and the Court of Appeals was in error in disregardi
the specific differences and improvements embodied in t
George device and resulting directly and necessarily fr
specific limitations and relationships defined in the clai

CONCLUSIONS

This argument has been unusually free of citations
prior decisions but this does not indicate that the qu
tions raised are mainly questions of fact as distinguish
from questions of law. Petitioners accept and rely on t
Court of Appeals' findings on purely factual questions
structure and function of the device of the patent in su
The very lack of citations indicates that petitioners a
not attempting to distinguish the facts of this case fr
other cases on some fine point of judicial interpretati
Rather, the whole make-up of the argument indicates t
very considerable degree in which the Court of Appe
has diverged from well accepted principles in reaching
conclusion, and the consequent need for review by t
Court.

The questions to be reviewed are almost exclusiv
legal and it is respectfully submitted that a proper int
pretation and application of the doctrine of the Sup
market case to the facts of this case, as stated by t

Court of Appeals, will require a reversal of the Court of Appeals' decision.

This Court stated in the Supermarket case:

> "The conjunction or concert of known elements must contribute *something;* only when the whole in someway exceeds the sum of its parts is the accumulation of old devices patentable • • •."

In this case the Court of Appeals has stated that the register support panel, in its new position in the George device, has advantages not provided by the closest prior art and performs an added function of acting as a stop. Here then is the contributed "something" and the "excess" of the accumulation over the "sum of its parts" which this Court has said are necessary to invention. Here then are the pre-requisites for holding the patent valid and for reversing the Court of Appeals decision.

In the Supermarket case this Court observed that:

> "• • • Neither court below has made any finding that old elements which made up the device perform any additional or different function in the combination than they perform out of it."

But in this case the Court of Appeals has found both an added function for the register support panel and a different and improved function for the device as a whole. Petitioners accordingly submit that the Supermarket case affirmatively requires a reversal of the Court of Appeals' decision on the grounds that the decision is contrary to this Courts' prior decisions.

The Supermarket case is also relied upon as indicating the propriety and necessity of granting this petition. In that case, as in this, the lower courts applied an improper test of patentability to the facts as found by them and

this Court should correct the error in this case as it did in the Supermarket case. The situation is all the more critical in this case in that the decisions of the lower courts are contrary to doctrine stated by this Court in the Supermarket case.

It is accordingly respectfully submitted that this petition for writ of certiorari should be granted.

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April, 1959.

APPENDIX

OPINION OF CIRCUIT COURT OF APPEALS

UNITED STATES COURT OF APPEALS FOR THE NINTH CIRCUIT

William T. Alvarado Sales Co., and Spee-Dee Checkout Systems, Inc., Appellants, v. Sidney S. Rubaloff and Abraham M. Gross, individually and doing business as Check-A-Matic Co., and Du-More Fixture Co., Inc., Appellees.	No. 15,855 Feb. 6, 1959

Appeal from the United States District Court for the Southern District of California, Central Division

Before: Barnes, Hamly, and Jertberg, Circuit Judges

HAMLEY, Circuit Judge:

This is a patent infringement suit between competing manufacturers and sellers of supermarket check stands. The trial court found and concluded that the patent is invalid because of the prior art and for lack of invention. Without reaching the question of infringement, therefore, the court entered judgments for the defendants. Plaintiffs appeal.

Plaintiff Spee-Dee Checkout Systems, Inc., is the owner of United States patent No. 2,599,909, issued June 10, 1952, to Will L. George. Plaintiff William T. Alvarado Sales Co. is the exclusive licensee of this patent in the state of California. Plaintiffs joined in bringing two patent infringement suits which were thereafter consolidated for trial and have been consolidated for appeal. In one suit Sidney S. Rubaloff and Abraham M. Gross, individually and as a partnership d.b.a. Check-A-Matic Co., were named defendants. In the other the defendant is Du-More Fxture Co., Inc.

The object of the patent, as stated therein, is to provide a stand for checking out the items of a customer's purchase in a grocery or other retail merchandising store. The stand is designed to speed up the operation of checking each item and to reduce the possibility of error in missing items or checking a single item twice.

The structure of the patented check stand is not complex. A rotatable receiving table is actuated by a concealed motor controlled by a switch operated by the checker. This turntable adjoins a discharge counter so that articles may be slid from the receiving table to the discharge counter. A support panel, constructed slightly above the quadrant of the turntable farthest from the customer and closest to the checker, provides a convenient place for the cash register. The left side of the support panel may also perform the additional function of acting as a stop for the articles being purchased. Provision is made for the installation of a separate stop bar on the receiving table if this is desired.[1]

[1] The claims in suit are Nos. 3, 5, 6, and 7 of the patent. The above description closely follows claim No. 6 and is fairly illustrative of the patent.

The trial court found that each of the individual components of the claimed invention was well known in the prior art and was in public use or on public sale in the United States more than one year prior to the date of the application for the George Patent.[2] The court also held that the utilization of these old components in this patent made no substantial advancement or improvement over the prior art in efficiency, function, relationship, or interaction of the parts and components one to the other.[3] It was on the basis of these findings and conclusions that the trial court determined that the patent is invalid.

Appellants specify as error the trial court's finding that each of the individual components of the claimed invention was well known in the prior art. Appellants assert that this finding is not based upon substantial evidence.

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[2] The trial court stated that examples of the prior art are to be found in the following patents. Tench—756,298; Brock et al—1,028,670; Goodrich—1,071,004; Johnson—1,143,279; Florence—1,400,948; Wilcox—1,664,055; Muse—2,237,080; Turnham—2,242,408; Price—2,268,897; Campbell—2,305,604; and Bradley—2,317,438.

[3] Amplifying this finding and conclusion, the court said:

"8. . . . The patentee has not produced any 'unusual or surprising consequences' from the aggregation of the old elements, the patent does not possess any patentable improvements over the prior art, and no patentable invention is contained or disclosed therein.

"9. The function of each of the various components of the alleged disclosed invention is not different from the function of each of said components as disclosed in the prior art and as disclosed in devices in prior public use or on public sale; nor is there any new relationship, coaction, or surprising result in the aggregation of the various components of the alleged invention.

"10. The difference between the alleged invention and the prior are was such that the alleged invention was obvious at the time of the alleged invention to a person having ordinary skill in the art. . . ."

The only argument we find in the body of appellants' brief in support of this specification is the observation that appellees had to go out of the "check stand" art into the "remote art of industrial conveyors" to find a turntable. Appellants are here referring to the turntable which is used as part of a paper milk bottle packaging machine covered by the Price patent.

Appellants are not correct in asserting that the only prior use of a turntable relied upon by appellees is that described in the Price patent. Appellees also rely on the Florence patent, which teaches the use of a turntable in connection with the display of groceries for customer selection.

It is true, as appellants contend, that there is no disclosure in the prior art of a turntable having been used in a check stand. But the display of groceries for customer selection and the packaging of paper milk bottles are, along with check stands, part of the art of handling small articles. If a component of a device used in one field of this art is old, it is old in all fields of that art. A showing that such a component has been put to a new use may be relevant in determining whether there is a patentable combination of old components, but it does not tend to show that the component is not old.

There is substantial evidence to support the finding of fact that all components of the claimed invention are old in the prior art. The turntable component has already been discussed. The use of a register support, though not in the position and with all of the advantages shown in the George patent, is taught in the Bradley and Muse patents. Discharge tables are shown in the same prior patents and aside from these patents have long been in public use. Stops to hinder the movement of articles or

to change the direction of movement are shown in the Bradley and Price patents.

The finding of fact that each of the component parts of the device described in the George patent was well known in the prior art is not clearly erroneous.

In view of this finding it follows that the manner in which any single component of the George patent is utilized therein will not suffice to establish patentability. The taking over of devices from one field of use to another does not constitute invention, even though they be put to a new use. More than a new advantage of the old component must be discovered in order to claim invention. General Electric Co. v. Jewel Co., 326 U. S. 242, 249.

Therefore, if the George patent is valid, it must be for the reason that it specifies an interrelation and coaction of old components sufficiently novel to meet the constitutional standard of invention.

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[4] At one point in their opening brief appellants appear to recognize that all components of the claimed invention are old in the prior art. They say: " . . . Nor did George utilize or rely on a newly discovered elements or tool to gain his ends. He used the same means available to all his predecessors but added his touch of inventive skill to make a materially improved device. . . ." At the opening of the trial, counsel for appellants told the court: ". . . The parts are old, admittedly, but they are brought together in a novel action, as we intend to show. . . ." A few minutes later this colloquy occurred betwen the trial court and counsel for appellants:

> "THE COURT: Is there anything new in any of this apparatus? You have taken various items that have been in the public domain and combined them in something that you claim is new, but is there anything new? MR. WEBB: No. THE COURT: Is there any part that is new, any claim of anything new? MR. WEBB: Broadly speaking, your Honor, we do not claim any specific item is absolutely new and cannot be found in the prior art. We claim that the combination is new in this art and that it gets a new and un-obvious result, as we will show."

The trial court, as we have noted, held that the patent in suit did not specify an interrelation and coaction of old components sufficiently novel to meet this test.[5] Appellants challenge both the findings of fact and the conclusions of law upon which this determination is predicated.[6]

The trial court did not set out in its findings of fact a factual comparison between the functioning of the components as utilized in the George patent and their functioning elsewhere. We therefore summarize the significant evidence which, as appellants state, is not seriously controverted.

The turntable utilized in the George patent performs the function of mechanically moving the customer's articles from the point where they are placed on the receiving table to a point within reach of the checker. In other check stands the articles after being placed on the receiving table are conveyed to the checker by means of U-shaped pull frames (Turnham and Bradley patents), counter buggies or rollers (Bradley patent), conveyor belts (Bradley and Muse patents), or by hand.

When a turntable is used to convey articles from the receiving stand to the checker, the arcuate movement of the turntable conveys the articles transversely away from the customer and towards the checker. This tends to bring the articles within easy reach and vision of the checker

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[5] See footnote 3.

[6] While denominated a finding of fact, this determination involves both a factual finding and a legal conclusion. What the components of the claimed invention do in the combination, as compared to what they do out of it, is a question of fact. Whether the additional or different functions, if any, which the components perform in the combination meet the standard of invention is a question of law. See Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp., concurring opinion by Mr. Justice Douglas, 340 U. S. 147, 155; Cee-Bee Chemical Co., Inc. v. Delco Chemicals, Inc., 9 Cir., — F. 2d —.

and his conveniently located cash register. It also operates to reduce the likelihood that articles will be inadvertently or fraudulently passed by without checking.

The prior art which comes closest to having the same advantages is the Bradley patent using a conveyor belt. When an attendant is used in the operation of the Bradley device as the patent contemplates, he stands on the checker's side of the receiving table. This naturally results in the placing of most articles on the side of the conveyor belt closest to the checker, and so brings them into convenient reach of the checker.

If a customer, rather than an attendant, unloads the articles upon the belt, a substantial number of the articles are likely to be placed on the customer's side of the belt. To the extent that this is done, either by the customer or the attendant, the articles will come to a stop at a place which is less convenient for the checker. As a matter of fact, however, the majority of such belts are eighteen inches wide. Articles placed anywhere upon a belt of that width would be within relatively easy reach of the checker. In addition it is the practice of some checkers to select items from the turntable or belt at random, or for the purpose of checking like articles together, without waiting for them to reach the stop bar.[1] Where this is the practice it is probably fair to say that it makes little difference whether a turntable or conveyor belt is used.

[1] Appellants are not claiming that the placing of a turntable in a check stand alone constituted the invention. This is indicated by a letter dated September 29, 1953, from appellants' counsel to Check-A-Matic's attorney, reading in part: "I am in agreement with Mr. Latta that the structure disclosed in the Check-O-Matic [sic] circular does not infringe the George patent. . . ." This circular shows an early model Check-A-Matic stand which has a turntable receiving counter, but with a movable register stand which does not overhang a quadrant of the turntable.

It is recognized that in the above discussion we have described these check stands and compared their strong and weak points in general terms. Both appellants and appellees will be able to suggest claimed advantages or disadvantages called to our attention in the briefs which are not mentioned in this opinion.[*] All such contentions have been carefully considered.

It is at once apparent, and appellees concede, that the George check stand is useful. The completness with which appellees have imitated the essential features of the George device is probably indicative of its superior qualities. See Florence-Mayo Nuway Co. v. Hardy, 4 Cir., 168 F. 2d 778, 782.

But the fact that old components have been put together in a way which had not been thought of before, with good results following, is not alone sufficient to establish patentability. As stated in Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp., 340 U. S. 147, 153:

> "• • • When, for the first time, those elements were put to work for the supermarket type of stores, although each performed the same mechanical function for them that it had been known to perform, they produced results more striking, perhaps, than in any previous utilization. To bring these devices together and apply them to save the time of customer and checker was a good idea, but scores of progressive ideas in business are not patentable, and we conclude on the findings below that this one was not."

The A. & P. case also involved the patentability of a check stand. In that case, as in this, all components were

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[*] Appellants, for example, also contend that the discharge counter coacts in a novel manner with the register support panel.

old in the art, and the question was whether they constituted a patentable combination or a nonpatentable aggregation. Concerning this question the Supreme Court observed that courts should scrutinize combination patent claims "with a care proportioned to the difficulty and improbability of finding invention in an assembly of old elements. * * *"

Stating and applying what it considered to be the appropriate test in such cases, the Supreme Court there said:

> "* * * The conjunction or concert of known elements must contribute something; only when the whole in some way exceeds the sum of its parts is the accumulation of old devices patentable. Elements may, of course, especially in chemistry or electronics, take on some new quality or function from being brought into concert, but this is not a usual result of uniting elements old in mechanics. This case is wanting in any unusual or surprising consequences from the unification of the elements here concerned. * * *
>
> "* * * This counter does what a store counter always has done—it supports merchandise at a convenient height while the customer makes his purchases and the merchant his sales. The three-sided rack will draw or push goods put within it from one place to another—just what any such a rack would do on any smooth surface—and the guide rails keep it from falling or sliding off from the counter, as guide rails have ever done. Two and two have been added together, and still they make only four."

Applying the test of the A. & P. case to the uncontroverted facts before us here, we hold that the trial court did not err in concluding that the George device is a nonpatentable aggregation of old components and therefore

invalid. Its components do not perform any additional or different function in the combination than they perform out of it. To be sure, they perform this same function differently, and perhaps better. This difference, and betterment, evidences the practical application of a good idea. It is not, however, an idea which in practice has produced such unusual or surprising consequences or has so added to the total stock of knowledge that it represents invention in the constitutional sense.

AFFIRMED.

(Endorsed:) Opinion. Filed Feb. 6, 1959.

Paul P. O'Brien, Clerk.

JUDGMENT OF CIRCUIT COURT OF APPEALS

UNITED STATES COURT OF APPEALS
FOR THE NINTH CIRCUIT

William T. Alvarado Sales Co., et al.,
Appellants,

v.

Sidney S. Rubaloff, et al.,
Appellees.

JUDGMENT

Appeal from the United States District Court for the Southern District of California, Central Division.

This cause came on to be heard on the Transcript of the Record from the United States District Court for the Southern District of California, Central Division, and was duly submitted.

On consideration whereof, it is now here ordered and adjudged by this Court, that the Judgment of the said District Court in this cause be, and hereby is affirmed.

(ENDORSED). Judgment.

Filed and entered: February 6, 1959.

PAUL P. O'BRIEN, Clerk.

ORDER DENYING REHEARING

UNITED STATES COURT OF APPEALS FOR THE NINTH CIRCUIT

Excerpt from Proceedings of Monday, March 9, 1959.

Before Barnes, Hamley and Jertberg, Circuit Judges.

ORDER DENYING PETITION FOR REHEARING

On consideration thereof, and by direction of the Court, it is ordered that the petition of Appellants, filed March 4, 1959, and within time allowed therefor by rule of Court for a rehearing of the above cause be, and hereby is denied.